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10/589,958	08/18/2006	Yuichi Idehara	1163-0579PUS1	1060
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VO, CECILE H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/589,958

Applicant(s)

IDEHARA ET AL.

Examiner

CECILE VO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Applicants' amendment received on 03/19/2008.

Claim Status

2. Claims 1 and 6-8 are amended.
3. **Claims 1-18** are currently presenting for examination, with claims 1, 6-8, 10 and 15-17 being independent.

Specification Objections

4. Applicant's amendment to objection of the abstract is acknowledged. Therefore, objection to the abstract is withdrawn.

Claim Objections

5. Applicant's amendment to objection of claim 8 is acknowledged. Therefore, objection to the claim is withdrawn.

Claim Rejections – 35 USC §101

6. Applicant's arguments to rejection of claims 1-9 under 35 U.S.C 101 is acknowledged. However, examiner is not persuaded.

As per Applicant's assertion that *"the claimed invention is directed to a "system". A "system" by its definition is a "physical object" or a "machine", which are statutory under 35 USC §101"*, the examiner respectfully disagrees. It is noted that

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use of the word "system" does not inherently mean that the claim is directed to a machine. Only if at least one of the claimed elements of the system is a physical part of a device can the system as claimed constitute part of a device or a combination of devices to be a machine within the meaning of 101. In this case, there is no explicit definition in the claims that the system limits to a combination of hardware and software. Thus, claims 1-9 are non-statutory.

Therefore, the examiner maintains the rejection to the claims.

7. This action has been made **FINAL**.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-5, 6, 7 and 8-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-5, 6, 7 and 8-9 are directed to a system comprising software per se. Software per se is not a series of steps or acts and thus is not a process. Software per se is not a physical article or object and as such is not a machine or manufacture. Software per se is not a combination of substances and thus, is not a composition of matter. Therefore, software per se is not one of the four categories of invention.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Shinohara, US Patent Number 7,310,514 B2.

Regarding claim 1, Shinohara discloses a media delivering apparatus which delivers media data to a media receiving apparatus by way of a network, characterized in that said apparatus comprises:

a parameter acquiring unit for acquiring both a communication capability of said network, and a receiving capability of said media receiving apparatus (e.g. determines whether the multimedia message that is to be transmitted by mobile telephone 10₁ can be received at transmission-destination mobile telephones 10₂-10₄, col. 7, lines 6-9. In additional, Shinohara discloses: the mobile wireless communication terminal in the present embodiment is a mobile telephone having CDMA communication capability, the present invention is not limited thereto, col. 5, lines 42-45);

a media selecting unit for selecting media data to be delivered based on both a degree of media importance assigned to each of said media data and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus (e.g. mobile telephone 10₁ notifies MMS user database server of information regarding the formats for each media type of the multimedia message, col. 6, lines 62-67);

a transmission-data generating unit for generating metadata in which both address information indicating a location of said selected media data and presentation layout information indicating a presentation layout of said media receiving apparatus which is determined based on both the degree of media importance of said selected media data and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus are described (e.g. MMS user database server 30 determines whether the multimedia message that is to be transmitted by mobile telephone, col. 7, lines 5-22);

a data transmitting unit for delivering said metadata to said media receiving apparatus by way of said network (e.g. the user of mobile telephone 10₁ modify the data format and then transmit the multimedia message, col. 7, lines 16-17); and

a media communication unit for delivering said media data in response to a request from said media receiving apparatus which has received said metadata (e.g. the user of mobile telephone 10₁ may modify the data of formats and then the multimedia message, col. 7, lines 31-34).

Regarding claim 2, Shinohara further discloses the media delivering apparatus, characterized in that said apparatus comprises a importance change monitoring unit for changing said degree of media importance in response to a change indication for changing said degree of media importance, and for notifying the change in said degree of media importance to the media selecting unit, and characterized in that said media selecting unit selects the media data to be delivered based on both the changed degree of media importance and at least the one of the communication capability of the network and the receiving capability of the media receiving apparatus, the transmission-data generating unit generates the metadata in which both the address information indicating the location of said selected media data which is selected based on both the changed degree of media importance and the presentation layout information indicating the presentation layout of said media receiving apparatus which is determined based on both the changed degree of media importance of said selected media data and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus are described, and the data transmitting unit delivers said changed metadata (col. 6, lines 29-38).

Regarding claim 3, Shinohara further discloses the media delivering apparatus, characterized in that said apparatus comprises a importance change monitoring unit for changing said degree of media importance in response to a

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change indication for changing said degree of media importance, and for notifying the change in said degree of media importance to the media selecting unit, and characterized in that said media selecting unit selects the media data to be delivered based both the changed degree of media importance and at least the one of the communication capability of the network and the receiving capability of the media receiving apparatus, the transmission-data generating unit generates a change command for changing the metadata which is generated before said degree of media importance is changed based on both the changed degree of media importance and at least the one of the communication capability of the network and the receiving capability of the media receiving apparatus, and the data transmitting unit delivers said change command (col. 7, lines 22-50).

Regarding claim 4, Shinohara further discloses the media delivering apparatus, characterized in that the transmission-data generating unit describes metadata including synchronization information indicating a timing for switching between screen displays in the media receiving apparatus in the metadata (col. 7, lines 23-25).

Regarding claim 5, Shinohara discloses the media delivering apparatus, characterized in that the transmission-data generating unit describes metadata including conditional branching information about at least the one of the communication capability of the network and the receiving capability of the media

receiving apparatus which are used for determining the presentation layout of the media receiving apparatus (col. 7, lines 1-21).

Regarding claim 6, Shinohara discloses a media delivering apparatus which delivers media data to a media receiving apparatus by way of a network, characterized in that said apparatus comprises:

a parameter acquiring unit for acquiring both a communication capability of said network, and a receiving capability of said media receiving apparatus (e.g. determines whether the multimedia message that is to be transmitted by mobile telephone 10₁ can be received at transmission-destination mobile telephones 10₂-10₄, col. 7, lines 6-9. In additional, Shinohara discloses: the mobile wireless communication terminal in the present embodiment is a mobile telephone having CDMA communication capability, the present invention is not limited thereto, col. 5, lines 42-45);

a media selecting unit for selecting media data to be delivered based on both a time-varying degree of media importance which is assigned to each of said media data, and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus (e.g. mobile telephone 10₁ notifies MMS user database server of information regarding the formats for each media type of the multimedia message, col. 6, lines 62-67);

a transmission-data generating unit for generating metadata in which both address information indicating a location of said selected media data and presentation layout information indicating a presentation layout of said media 10

receiving apparatus which is determined based on both the time-varying degree of media importance of said selected media data and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus are described (e.g. MMS user database server 30 determines whether the multimedia message that is to be transmitted by mobile telephone, col. 7, lines 5-22);

a data transmitting unit for delivering said metadata to said media receiving apparatus by way of said network (e.g. the user of mobile telephone 10₁ modify the data format and then transmit the multimedia message, col. 7, lines 16-17); and

a media communication unit for delivering said media data based in response to a request from said media receiving apparatus which has received said metadata (e.g. the user of mobile telephone 10₁ may modify the data of formats and then the multimedia message, col. 7, lines 31-34).

Regarding claim 7, Shinohara discloses a media delivering apparatus which delivers media data to a media receiving apparatus by way of a network, characterized in that said apparatus comprises:

a parameter acquiring unit for acquiring both a communication capability of said network, and a receiving capability of said media receiving apparatus (col. 7, lines 6-9 and col. 5, lines 42-45);

a media selecting unit for selecting media data to be delivered based on both a time-varying degree of media importance which is assigned to each of

said media data, and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus (col. 6, lines 62-67);

a transmission-data generating unit for generating initial metadata at a time of start of presentation, in which both address information indicating a location of said selected media data and presentation layout information indicating a presentation layout of said media receiving apparatus which is determined based on both the time-varying degree of media importance of said selected media data and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus are described, and for generating a change command for changing said initial metadata according to a variation with time of said degree of media importance (col. 7, lines 5-22);

a data transmitting unit for delivering said initial metadata and said change command to said media receiving apparatus by way of said network (e.g. the user of mobile telephone 10₁ modify the data format and then transmit the multimedia message, col. 7, lines 16-17); and

a media communication unit for delivering said media data based in response to a request from said media receiving apparatus which has received said initial metadata and said change command (e.g. the user of mobile telephone 10₁ may modify the data of formats and then the multimedia message, col. 7, lines 31-34).

Regarding claim 8, Shinohara discloses a media receiving apparatus which receives media data delivered thereto by way of a network, characterized in that 25 said apparatus comprises:

a data receiving unit for, based on both a degree of media importance assigned to each of said media data and both a communication capability of said network and a receiving capability of said media receiving apparatus, receiving metadata in which both address information indicating a location of media data to be delivered and presentation layout information indicating a presentation layout of said media receiving apparatus are described (col. 7, lines 6-9 and col. 5, lines 42-45);

a data analyzing unit for analyzing said metadata received by said data receiving unit (col. 6, lines 1-6);

a real-time streaming protocol (RTSP) communication unit for making a request for delivery of said media data based on the address information described in said metadata analyzed by said data analyzing unit (e.g. request mail server 150 for reception, col. 1, lines 50-58);

a media receiving unit for receiving the media data delivered to said media receiving apparatus (e.g. MMS servers 50₁-50₃, Fig. 3, store multimedia messages by media type, col. 5, lines 59-60. Wherein, all types of multimedia messages may be held in a single MMS server, col. 5, lines 65-66); and

a media display unit for presenting the received media data based on the presentation layout information described in said metadata analyzed by said data analyzing unit (col. 7, lines 22-24).

Regarding claim 9, Shinohara further discloses the media receiving apparatus, characterized in that the data receiving unit receives a change command for changing the received metadata as the degree of media importance is changed, and the data analyzing unit interprets said change command received by said data receiving unit, and updates said received metadata (col. 7, lines 22-50).

Claims 10-18 recite "methods" are similar to claims 1-9, therefore claims 10-18 are rejected by the same reasons.

Response to Arguments

3. Applicant's arguments filed 03/19/2008 have been fully considered but they are not persuasive.

In response to applicant's argument, Shinohara fails to teach or suggest "a *parameter acquiring unit for acquiring both a communication capability of said network, and a receiving capability of said media receiving apparatus*". The examiner respectfully disagrees.

Shinohara discloses: " determines whether the multimedia message that is to be transmitted by mobile telephone 10₁ can be received at transmission-destination mobile telephones 10₂-10₄, col. 7, lines 6-9" as a receiving capability. Shinohara further discloses "*the mobile wireless communication terminal in the*

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present embodiment is a mobile telephone having CDMA communication capability, the present invention is not limited thereto", col. 5, lines 42-45". Wherein, the Code Division Multiple Access (CDMA) communication method (as a communication capability) in the next-generation mobile telephone systems, it will be possible to **transmit and receive** a variety of data including text, graphics, video, and audio, as messages, col. 2, lines 4-10. Therefore, it is understood that "*a parameter acquiring unit for acquiring both a communication capability of said network, and a receiving capability of said media receiving apparatus*" is not limited in the teaching of Shinohara.

The applicant's argument only states that Shinohara fails to teach or suggest "*a parameter acquiring unit*", but does not appear to present any clarity or submit that the limitation is fully supported by the originally-filed specification. If the Applicant are claiming a specific type of "*parameter acquiring unit*", then the Applicant need to amend the claims to state what this "*parameter acquiring unit*" process is performing and manipulating.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CECILE VO whose telephone number is (571)270-3031. The examiner can normally be reached on Mon - Thu (9AM - 5:00PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on 571-272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 16, 2008

/Cecile Vo/
Examiner
Art Unit 2169

/H. Q. P./
Primary Examiner, Art Unit 2168

/Mohammad Ali/
Supervisory Patent Examiner, Art Unit 2169